

**Notice of Allowability**

Application No.

10/766,263

Applicant(s)

MEESE ET AL.

Examiner

Zachary C. Tucker

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to \_\_\_\_.
2. ☒ The allowed claim(s) is/are 50-63.
3. ☒ The drawings filed on 27 January 2004 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/700,094.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date \_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material

5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_

JAMES O. WILSON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

The following amendments to the specification are necessary to render the instant application compliant with 37 CFR 1.77 (arrangement and contents of the specification) and 37 CFR 1.78(a)(1)(iv)(i) (cross-reference to related applications), and reflect the arrangement and contents of the specification of the parent application, 09/700,094. Applicants' preliminary amendment filed 27 January 2004 included a cross-reference to the parent application, serial number 09/700,094, but that application had not yet issued as a patent. The cross-reference to the parent application is re-stated hereinbelow, with added reference to the patent number of the parent application.

#### **IN THE SPECIFICATION –**

At page 1, under the title of the application, insert the following paragraph:

"The present application is a Continuation Application of USSN 09/700,094, filed January 2, 2001, now US Patent 6,713,464, which in turn claimed the priority benefit of PCT/EP99/03212, filed May 11, 1999."

Followed by the heading:

**--BACKGROUND OF THE INVENTION--**

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At page 3, line 17 (before the paragraph that begins "It is an object...") insert the heading:

**--SUMMARY OF THE INVENTION--**

At page 4, starting at line 4 (BEFORE the paragraph beginning that begins "According to the present invention..." insert the following paragraph and headings:

**--BRIEF DESCRIPTION OF THE DRAWING**

FIG. 1 shows the formation of the active metabolite from different prodrugs by human liver S 9(%) in 1 hour.

**DETAILED DESCRIPTION OF THE INVENTION--**

end of amendments

***Response to Amendment***

As requested in the correspondence from applicants filed 28 February 2005, which is in reply to the Office action mailed 29 November 2004 (hereinafter "previous Office action"), claims 28-49 have been cancelled and new claims 50-63 added.

***Election/Restrictions***

Applicants have presented a new claim set, numbered 50-63, wherein no subject matter other than as was set forth in Group I of the Requirement for Restriction mailed 28 September 2004 is recited.

As was indicated in the previous Office action, page 2, in the section headed "Election/Restrictions," R and/or R' = "allyl" is part of Group I, the elected group. This was confirmed in a telephone conversation between applicants' counsel and the examiner after the previous Office action was mailed.

***Status of Claim Rejections - 35 USC § 112***

In the previous Office action, claims 41 and 42 were rejected under the second paragraph of 35 U.S.C. 112, because, it was asserted, the preamble of those claims was repugnant to the actual process described.

Claims 41 and 42 have been cancelled, mooted the rejection of those claims.

***Claim Rejections - 35 USC § 102***

In the previous Office action, claims 28, 29 and 31 were rejected under 35 U.S.C. 102(b) as being anticipated by US 5,686,464 (Johansson et al).

Claims 28, 29 and 31 have been cancelled, mooted the rejection of those claims.

### ***Claim Objections***

In the previous Office action, claims 32, 36 and 37 were objected to for recitations of non-elected subject matter, but indicated as allowable, insofar as the elected subject matter was concerned.

In the previous Office action, claims 39, 43 and 46-49 were objected to as depending from a rejected base claim, and also for recitation of non-elected subject matter, and indicated as allowable insofar as the elected subject matter was concerned.

All claim objections are rendered moot by cancellation of all previously pending claims.

As indicated above in the section headed "Election/Restrictions," the new claim set is free of the non-elected subject matter.

### ***Allowable Subject Matter***

Claims 50-63 are allowed.

The following is an examiner's statement of reasons for allowance:

No disclosure rendering obvious or anticipating compounds according to instant claims 50-55, the composition according to claim 56, the process according to claims 57-59 or the methods according to claims 60-63 is found in the prior art.

The previously stated rejections under 35 U.S.C. 102(b) of claims 28, 29 and 31 were erroneous, because the proviso in those claims, which proviso excludes those compounds wherein R' is not benzyl when R is hydrogen. This was inadvertently overlooked in the preparation of the previous Office action.

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Also, the same proviso excludes those compounds wherein R is ethyl when R' is hydrogen. This is important because, as indicated in the previous office action, at least one such compound is claimed in US 6,313,312 (Johansson et al). No such compound is claimed in the instant application.

The closest prior art with respect the instantly claimed compounds is the afore-cited US 5,686,464 (Johansson et al), and

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

**Conclusion**

All Post-Allowance Correspondence concerning this application must be mailed to:

Mail Stop Issue Fee  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or you can fax them to the Office of Patent Publications at 703-872-9306, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312; information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

For information concerning status of correspondence sent after receipt of the Notice of Allowance, please contact the Correspondence Branch at (703) 305-8027. The Notice of Allowance also has an insert containing contact information on other items, including Issue Fees, receipt of formal drawings and the status of the application.

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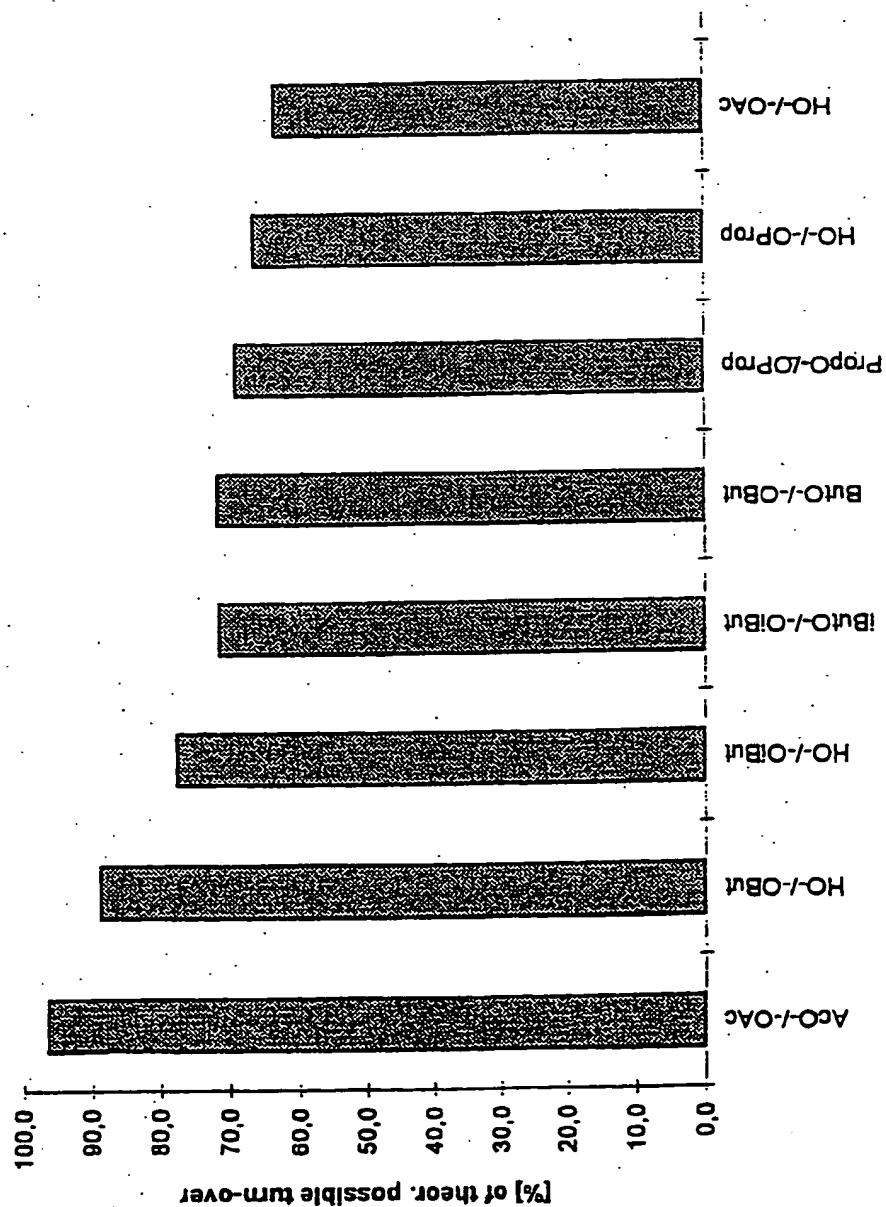
  
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FIG. 1

FORMATION OF THE ACTIVE METABOLITE FROM DIFFERENT PRODRUGS BY HUMAN LIVER S 9 (%) IN 1h



BEST AVAILABLE COPY